

A proper *prima facie* case of obviousness requires that the cited references when combined must “teach or suggest all the claim limitations,” and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the present §103(a) rejection of independent claims 1 and 16-20, in that the Nishioka and Kyojima references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for modifying the reference teachings to reach the claimed invention. Further, even if it is assumed that a proper *prima facie* case has been established, there are particular teachings in one or more of the references which controvert the obviousness argument put forth by the Examiner.

Independent claim 1 is directed to a method for controlling access to one or more information items purchasable from a merchant and accessible over a network, wherein a user interested in a given information item is permitted to access a corresponding signed ciphertext of the given information item, and the signed ciphertext has at least a first ciphertext portion. The method includes the following steps, denoted (a) and (b) herein for ease of discussion:

(a) receiving from the user a blinded version of the first ciphertext portion of the signed ciphertext in conjunction with a request from the user for purchase of the given information item from the merchant; and

(b) decrypting the blinded version of the first ciphertext portion and returning to the user the resulting decrypted blinded version of the first ciphertext portion, wherein the resulting decrypted blinded version provides information that is utilized by the user in conjunction with accessing the given information item in a manner such that the merchant is unable to identify the given information item purchased by the user.

An important advantage of the claimed arrangement relative to conventional techniques is that it “ensures that no one other than the user is able to determine what particular information item has been purchased” (Specification, page 3, lines 10-11).

The Examiner in formulating the § 103(a) rejection of claim 1 acknowledges that the Nishioka reference fails to teach or suggest the claimed use of a blinded version of a first ciphertext portion of a signed ciphertext, as set forth in steps (a) and (b) of claim 1, but argues that these missing teachings are provided by Kyojima. Applicants respectfully disagree.

The Examiner specifically relies on the teachings of Kyojima in column 4, lines 57-67, as well as in columns 5-14 and the accompanying figures. Column 4, lines 57-67 of Kyojima provides as follows:

The present invention has been made in view of the above circumstances and has an aspect to provide a blind decryption that can securely transmit a specific piece of information to a decryption device while keeping the blindness of data delegated to be decrypted.

There is no teaching or suggestion in the above portion of Kyojima, or in the other portions of Kyojima relied upon by the Examiner, regarding the claimed use of a blinded version of a first ciphertext portion of a signed ciphertext of a given information item purchasable from a merchant. Instead, Kyojima simply discloses a particular blind decryption technique. Applicants have been unable to find any mention whatsoever in Kyojima regarding a signed ciphertext, much less a blinded version of a first ciphertext portion of a signed ciphertext as claimed.

It is therefore apparent that Nishioka and Kyojima, even if assumed to be combinable, fail to teach or suggest limitations (a) and (b) of claim 1 which relate to processing of a blinded version of a first ciphertext portion of a signed ciphertext of a given information item purchasable from a merchant. In fact, the collective teachings of these references fail to even mention a signed ciphertext.

Claim 1 thus includes one or more limitations which are not taught or suggested by the proposed combination of Nishioka and Kyojima. The combined teachings of these references

therefore fail to “teach or suggest all the claim limitations” as would be required by a proper §103(a) rejection.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for modifying the reference teachings to reach the claimed invention. Neither Nishioka nor Kyojima makes any mention regarding processing of a blinded version of a first ciphertext portion of a signed ciphertext of a given information item purchasable from a merchant. However, the Examiner states that it would be obvious to modify the teachings of these references to include the limitations in question because “one of ordinary skill in the art would recognize the benefit of utilizing a blind ciphertext decryption method to accomplish access control and authentication to digital data without disclosing unnecessary purchase information” (Office Action, page 2).

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to modify the proposed combination of Nishioka and Kyojima to produce the particular limitations in question. The above-quoted statement of obviousness given by the Examiner in the Office Action is precisely the type of subjective, conclusory statement that the Federal circuit has indicated provides insufficient support for an obviousness rejection.

Further, even if it is assumed that a proper *prima facie* case has been established, there are particular teachings in one or more of the references which controvert the obviousness argument put forth by the Examiner. As characterized by the Examiner, Nishioka discloses an arrangement in which “selective information relating to a purchase request by a user is only known to a merchant and certain authentication information is obtained by a payment center” (Office Action, page 2). Assuming for purposes of argument that this characterization of Nishioka is correct, it represents a

specific teaching away from the present invention as set forth in claim 1. As noted above, claim 1 specifies that the decrypted blinded version provides information that is utilized by the user in conjunction with accessing the given information item in a manner such that the merchant is unable to identify the given information item purchased by the user. Since Nishioka, as characterized by the Examiner, teaches that an information item purchased by a user can be identified by the merchant, it teaches away from the claimed invention, and teaches away from the proposed combination with Kyojima. Such a teaching away is believed to constitute strong evidence of non-obviousness.

Applicants therefore respectfully submit that independent claim 1 is allowable over Nishioka and Kyojima.

Independent claims 16 and 17 each include limitations corresponding to steps (a) and (b) above, and are therefore believed allowable for the reasons identified above with regard to independent claim 1.

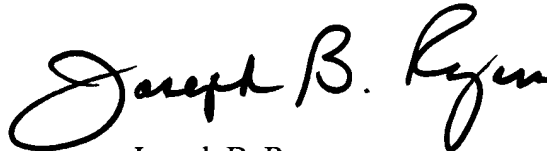
Independent claims 18-20 recite limitations relating to a user purchase request which includes information generated using at least a portion of an encrypted version of a given information item purchasable from a merchant. Further, access to the given information item is provided in a manner such that the merchant is unable to identify the given information item purchased by the user. Such limitations are not taught or suggested by the combined teachings of Nishioka and Kyojima, for reasons similar to those described above with reference to claim 1. Claims 18-20 are therefore believed to be allowable over the proposed combination of Nishioka and Kyojima.

Dependent claims 2-15 are believed allowable for at least the reasons identified above with regard to independent claim 1, and these dependent claims are also believed to specify additional separately-patentable subject matter.

With regard to the Zheng reference, this reference fails to supplement the above-described fundamental deficiencies of Nishioka and Kyojima as applied to independent claim 1.

In view of the above, Applicants believe that claims 1-20 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink that reads "Joseph B. Ryan". The signature is fluid and cursive, with the first name "Joseph" being more prominent than the last name "Ryan".

Date: August 28, 2003

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